

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/400,757	09/21/99	THUESON	D 246/221

PAUL H MEIER  
LYON AND LYON LLP  
47TH FLOOR  
633 WEST FIFTH STREET  
LOS ANGELES CA 90071

HM12/0612

EXAMINER

HARRISON, R

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

06/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/400,757**

Applicant(s)

**Hahn et al**

Examiner  
**Robert H. Harrison**

Art Unit  
**1619**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25, 52, 55, 61-69, 77-80, 84, 85, and 98-114 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-25, 52, 55, 61-69, 77-80, 84, 85, and 98-114 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

Art Unit: 1619

### **DETAILED ACTION**

The request filed on March 27, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/400,757 is acceptable and a CPA has been established. An action on the CPA follows.

#### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-25, 52, 55, 61, and 100, drawn to a composition and method for inhibiting skin irritation;.

Group II, claim(s) 62-69, 77-80, 84-85, 98-99, and 101-114, drawn to a composition and method for inhibiting skin irritation.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I requires an irritant ingredient while Group II does not.

Art Unit: 1619

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

1. Alphahydroxy acids, lactic acid glycolic acid, alphahydroxy decanoic acid, alphahydroxy octanoic acid, malic acid, tartaric acid and mandelic acid;
2. Betahydroxy acids, salicylic acid, capryloyl salicylic acid, citric acid and tartaric acid;
3. Keto acids and pyruvic acid;
4. Retinoids, tretinoin, retinol and retinal;
5. Peroxides and benzoyl peroxide;
6. Organic alcohols;
7. Carboxylic acids, acetic acid, 1-pyrrolidone-5-carboxylic acid, benzylic acid, gluconic acid and trichloroacetic acid;
8. Gluconolactone (lactones);
9. Methoxypropyl gluconamide;
10. Oxalic acid (dicarboxylic acids) and
11. Phenol.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument

Art Unit: 1619

that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. The claims are deemed to correspond to the species listed above in the following manner:

The following claim(s) are generic: 1-12, 52, 55, 57, 58, 61, and 100

5. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: their structural dissimilarity.

6. If Group II is elected, a further election of species is required as follows:

7. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

12. A method for inhibiting ocular irritation;

13. A method for inhibiting respiratory system irritation;

Art Unit: 1619

14. A method for inhibiting gastrointestinal system irritation;
15. A method for inhibiting reproductive system irritation;
16. A method for inhibiting mucous membrane irritation;
17. A method for inhibiting epidermal skin irritation;
18. A method for inhibiting dermal skin irritation;
19. A method for inhibiting skin irritation due to sunlight;
20. A method for inhibiting skin irritation due to low humidity;
21. A method for inhibiting skin irritation due to wind;
22. A method for inhibiting skin irritation due to cold temperature;
23. A method for inhibiting skin irritation due to hot and humid conditions.
24. A method for inhibiting skin irritation due to a chemical agent;
25. A method for inhibiting skin irritation due to shaving;
26. A method for inhibiting skin irritation due to skin cleansing or bathing;
27. A method for inhibiting skin irritation due to physical skin trauma.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Art Unit: 1619

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

8. The claims are deemed to correspond to the species listed above in the following manner:

The following claim(s) are generic: 101

9. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: their divergent subject matter requiring separate patentable consideration.

10. A telephone call was not made to request an oral election to the above restriction requirement.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).


Art Unit: 1619

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert H. Harrison whose telephone number is (703) 308-2422. The examiner can normally be reached on Monday-Thursday from 7:30 a.m. to 6:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L. Dudash, can be reached on (703) 308-2328

The fax phone number for most official papers or communications to Technology Center 1600/2900 - Group 1610 - Art Unit 1619 is (703) 308-4556 or (703) 308-4242 or (703) 305-1935. Such papers or communications must conform with the notice published in the Official Gazette, 1096 OG 30; November 15, 1989.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1610 receptionist whose telephone number is (703) 308-1234.

  
**Robert H. Harrison**  
**Primary Examiner**  
**Tech. Center 1600/2900**  
**Group 1610**  
**Art Unit 1619**

RHHarrison/rhh  
June 11, 2001